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REMARKSResponse to Objection under 35 U.S.C. § 132, introduction of new matter

The disclosure of the invention has been objected to under 35 U.S.C. § 132 because it is believed that new matter has been introduced by amendment of the claims to include the phrase "d) a tracking process that tracks the user's progress through the network website." Applicant respectfully submits that this material, which was added into claims 26 and 34 in the last response, *is* supported by the original disclosure. From an initial standpoint, pending claims 21 and 25 were filed with the original specification and contain the following language that supports this material: "transmitting user identification data from the remote user's computer to the central host server thereby allowing the central host server to identify and track the user's progress through the network web site" (emphasis added). Further, this tracking functionality is also referenced in the written description by discussions such as those directed to "preview history" (which allows users to review their prior music selections that have been previously tracked and stored) and "profile" (which involves use of additional tracked and stored activities pertaining to the user's prior navigation); see, e.g., col. 16, lines 9-18. Moreover, Figure 39 specifically teaches the tracking functionality associated with the "preview history" feature, namely, user access to their personal music sampling history, as also seen in more detail in Figure 42. It is submitted that the disclosure of a "central host server" that "track[s] the user's progress through the network web site," along with all of the additional detail found in the specification (such as, for example, the "preview history" subject matter, discussed above), adequately supports a "tracking process" that carries out such tracking functionality. Therefore, it is respectfully submitted that in view of the above-mentioned support from the original disclosure, the instant objection under 35 U.S.C. § 132 should be withdrawn.

Response to Objection to material shown in figure, but not described in specification

The disclosure of the invention has been objected to because of the informality that some of the language recited in new claims 52, 54, 55, 57, 58, 60, 61, 63, 64 and 66 is not contained in the specification. It was stated that "[t]he claimed subject matter 'between 3 and 8 discrete rating selections' is shown in FIG 4, but not described in the specification." As appropriate correction, the relevant claims have been amended to recite 'wherein the user is graphically provided with

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"about 5" discrete rating selections. Though one preferred embodiment shows a display with 5 discrete rating selections, the invention is flexible with respect to such graphical/software display-related functionality. For example, Figure 4 shows a rating query that asks only for two discrete rating selections (the "yes" or "no thank you" options associated with the "would you buy this CD?" query). Indeed, the written description associated with Figure 4 states that such software displays are "flexible and dynamic," and purview of other than exactly 5 discrete rating selections is one of the "modifications" contemplated by the discussion associated with the rating screen shown in Figure 4 with respect to the claimed invention. (Col. 8, lines 18-25.) Therefore, it is respectfully submitted that in view of these amendments, the instant objection has been overcome.

Response to Claim Objection under 37 C.F.R. § 1.75(c), failing to further limit

Claims 53, 56, 59 and 65 stand objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. It has been indicated that "[t]he word music as used in said claims does not further limit the invention." In response, Applicant has changed all occurrence of the word "music" in claims 53, 56, 59 and 65 to the appropriate limiting language to the claimed type of subject matter (e.g., video products). In view of the amendments set forth herein, it is respectfully submitted that the instant objection has been overcome.

Response to Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 39, 43, 44, 61, 62, 64 and 65 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It has been stated that the specification teaches the use of the invention with music and video, but fails to describe its use with regard to written works.

Although Applicant respectfully submits that the specification *does* describe the use of the invention with regard to written works, Applicant seeks to expedite the allowance of the video products claims, and thus has decided to cancel the written works claims (claims 39-51 and 61-66) without prejudice and file them in a continuing application. Applicant will establish the invention's contemplation and use of with regard to written works in that forum. It is respectfully

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submitted that in view of these claim cancellations, the instant rejection under 35 U.S.C. § 112 has been overcome.

Claims 26-37, 44 and 46-51 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It has been stated that it is unclear if applicant is claiming method steps, or further limiting the article as set forth in the preamble. As seen in the clean claims above as well in the appended 'version with markings to show changes made,' the relevant claims have been amended to more clearly define the subject invention. In particular, the relevant independent claims have been amended to positively recite either a method or an apparatus. It is respectfully submitted that in view of these amendments to the claims, the instant rejection under 35 U.S.C. § 112 is rendered moot and/or has been overcome.

Response to Rejection Under 35 U.S.C. § 102(e)

Claims 21-41, 43-51, 53, 56, 59, 62, 64 and 65 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 5,918,213 to Bernard ("Bernard"), filed 12/22/1995. It has been stated that all elements of the above claims are taught by Bernard.

Whether or not Bernard is prior art to the pending claims, it is respectfully submitted that Bernard does not teach or suggest all of the limitations of the rejected claims, as amended, so as to anticipate them.² Bernard discloses a telephonic system and method for automated previewing and purchasing of music products, specifically, the 1-800-MusicNow service offered by MCI Communications at the time Bernard was filed. Specifically, Bernard is directed to the concerns that the present caller, who remains unidentified except with regard to purchase-related actions, wishes to purchase a music product or achieves an "abusive status" notation that is indicative of excessive sampling of music products without making purchases. Some "profiling information" can also be collected by Bernard, such as statistical information, "quantity and frequency of browses, quantity and frequency of purchases, types of purchases [etc.]" (Col. 31, lines 36-50). Finally, Bernard mentions that the disclosed system might be used in association with a network

² It is believed that the effective date of the present claims is earlier than the filing date of Bernard. Applicant's decision to distinguish the reference is not an admission that Bernard is correctly cited as prior art.

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connection (e.g., the Internet) for the purposes of previewing and purchasing video products, although much significant teaching is absent from the specification of Bernard in this regard.

By contrast, in all of the independent claims presently at issue (claims 21, 25, 26 and 34), as amended, the method and computer system claims require transmission of user identification data (identification of the specific user) *prior* to preview of the pre-selected portion of the pre-recorded video product in question as well as tracking of the remote user's actions. Furthermore, these amended claims also require that data corresponding to the remote user's activities on the network web site is associated with the user identification data such that all previewed video products can be associated with the remote user who previewed them.

In Bernard, there is no teaching or suggestion that a remote user is specifically identified to a central host server prior to preview of the video product. Moreover, there is no functionality that allows the remote user's activities to be tracked such that the previewed video products can be associated with the remote user who previewed them, as now set forth in the claims. Bernard teaches that a user can become a "member" of the system, but only from the standpoint of "facilitating automated order processing" (col. 3, lines 63-65); it is repeatedly emphasized that the benefit of this membership profile is avoiding the burdens and risks of entering purchase information each time the user places a order (See, e.g., col. 4, lines 4-5, 8-10 and 15-17; col. 10, lines 56-60). Further, Bernard universally associates member status with purchase, stating (as just one example) that "a non-member ... can even purchase products. However, because a non-member does not have a membership profile, the non-member will speak to a sales representative to complete the sale" (Col. 10, lines 51-54). Indeed, the Bernard system is described as operating in general without even having access to the membership profile (col. 29, line 55 – col. 30, line 3). Thus, the claimed identification and tracking of the remote user is not taught or suggested by the membership profile of Bernard, nor is it inherent to the reference.

Similarly, while Bernard mentions that the profiling information can include profiles on individual callers (Col. 31, lines 36-38), it is clear that the process for specifically identifying the user occurs only with regard to purchasing or purchase-related information (i.e., items in shopping cart) and there is no suggestion for tracking and storing a list of samples that a user has listened to. For example, while one embodiment of Bernard discusses a keypad-activated "script" that can store a previewed CD in the user's shopping cart (see, e.g., Figs. 19, 29, 30 and 36 and associated written description), this functionality cannot involve the tracking of sampled video products as

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set forth in claims 21, 25, 26 and 34. Specifically, in Bernard, "the product identification number is [merely] appended to the order information to maintain a list of products selected by the customer" (Col. 5, lines 42-45; see also col. 30, lines 23-40), whereas the present claims require electronic recordation of the remote user's activities and storage of the sampled pre-selected portion of pre-recorded video products in association with the specific user who previewed them. Therefore, it is respectfully submitted that independent claims 21, 25, 26 and 34 (as well as all of their dependent claims covered by this rejection) are not rendered unpatentable by the cited reference under 35 U.S.C. § 102.

Applicant also submits today, by way of IDS via mail, two recent Orders from the pending litigation (Civil Action No. C 00 1156 DLI, in the United States District Court for the Northern District of California) concerning the validity of claims 1 and 5-18 of related U.S. Patent No. 5,963,916. Applicant disagrees with the rulings and may seek to overturn them on appeal to the Court of Appeals for the Federal Circuit.

With regard to previous information submitted from the pending litigation (see Information Disclosure Statements submitted on October 23, 2001 and January 16, 2002), Applicant respectfully urges the Examiner to consider these submissions.

In view of the amendments and remarks provided herein, it is respectfully submitted that the instant claim rejections have been overcome. If there are any additional charges, please charge them to our Deposit Account Number 04-0822.

Respectfully submitted,
DERGOSITS & NOAH LLP

Dated: August 9, 2002

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In The Claims:

21. (Once Amended) A method for enabling a remote user to preview a portion of a pre-recorded video product from a network web site containing pre-selected portions of different pre-recorded video products, using a computer, a computer display and a telecommunications link between the remote user's computer and the network web site, the method comprising the steps of:

a) using the remote user's computer to establish a telecommunications link to the network web site wherein the network web site comprises (i) a central host server coupled to a communications network for retrieving and transmitting the pre-selected portion of the pre-recorded video product upon request by a remote user and (ii) a central storage device for storing pre-selected portions of a plurality of different pre-recorded video products;

b) prior to previewing a pre-selected portion of a pre-recorded video product, transmitting user identification data from the remote user's computer to the central host server thereby allowing the central host server to identify and track the user's progress through the network web site;

c) choosing at least one pre-selected portion of the pre-recorded video products from the central host server;

d) receiving the chosen pre-selected portion of the pre-recorded products;
[and]

e) interactively previewing the received chosen pre-selected portion of the pre-recorded video product; and

f) storing data corresponding to the remote user's activities on the network web site along with the user identification in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them.

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25. (Once Amended) A method for enabling a remote user to preview a portion of a pre-recorded video product from a network web site containing pre-selected portions of different pre-recorded video products, using a computer, a computer display and a telecommunications link between the remote user's computer and the network web site, the method comprising the steps of:

- a) using the remote user's computer to establish a telecommunications link to the network web site wherein the network web site comprises (i) a central host server coupled to a communications network for retrieving and transmitting the pre-selected portion of the pre-recorded video product upon request by a remote user and (ii) a central storage device for storing pre-selected portions of a plurality of different pre-recorded video products;
- b) prior to previewing a pre-selected portion of a pre-recorded video product, transmitting user identification data from the remote user's computer to the central host server thereby allowing the central host server to identify and track the user's progress through the network web site;
- c) choosing at least one pre-selected portion of the pre-recorded video products wherein the portion of the pre-recorded product is identified by a product code;
- d) receiving the chosen pre-selected portion of the pre-recorded video products; [and]
- e) interactively previewing the received chosen pre-selected portion of the pre-recorded video product; and
- f) storing data corresponding to the remote user's activities on the network web site along with the user identification in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them.

26. (Twice Amended) A computer system [network web site for allowing a remote user to preview a pre-selected portion of a pre-recorded video product, using a computer, a computer display and a telecommunications link between the remote user's computer and the network web site, the network web site] comprising:

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a) a networked central host server [coupled to a communications network for] that retrieves[ing] and transmits[ting the] a pre-selected portion of a[the] pre-recorded video product upon request by a [the] remote user over a telecommunications link, the central host server hosting a web site that enables preview of pre-selected portions of pre-recorded video products on a computer associated with the remote user;

b) a central storage device that[for] stores[ing] pre-selected portions of a plurality of different pre-recorded video products, the central storage device coupled to the central host server; and

c) machine executable programs of instructions that provide: an identification (ID) process that recognizes [a]user identification data[ID], transmitted from the remote user's computer to the central host server, which specifically identifies the remote user to the central host server prior to preview of the pre-selected portion of the pre-recorded video product by the remote user;[

d)] a tracking process that tracks the remote user's progress through the network web site; and[

e)] a control process that provides the remote user with interactive control over the preview of the pre-selected portion of the pre-recorded video products;

wherein data corresponding to the remote user's activities on the network web site is stored along with the user identification data in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them.

27. (Once Amended) The computer system[network web site] of Claim 26 wherein the portions of the plurality of different pre-selected pre-recorded video products are identified and called from the central storage device using unique product codes.

28. (Twice Amended) The computer system[network web site] of Claim 26 further comprising a machine executable program of instructions that provides a purchasing process that allows the user to place an order for purchasing at least one video product.

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29. (Twice Amended) The computer system[network web site] of Claim 26 further comprising a machine executable program of instructions that provides a listing process that provides the user with dynamic lists of the pre-selected portions of the plurality of different pre-recorded video products that have been previewed the most.

30. (Twice Amended) The computer system[network web site] of Claim 26 further comprising a machine executable program of instructions that provides a recording process that provides the user with a record of previous previews by the user.

31. (Twice Amended) The computer system[network web site] of Claim 26 further comprising a machine executable program of instructions that provides a ratings process that prompts the remote user for a user's rating of a particular one of the pre-selected portions of the plurality of different pre-recorded video products and stores the user's rating.

32. (Twice Amended) The computer system[network web site] of Claim 31 further comprising a machine executable program of instructions that provides a first market research process that correlates the user's rating with the user identification data[ID], for compiling market research data.

33. (Twice Amended) The computer system[network web site] of Claim 26 further comprising a machine executable program of instructions that provides a second market research process that correlates the user identification data[ID] with all previews performed by the remote user, for compiling market research data.

34. (Twice Amended) A computer system[network web site for allowing a remote user to preview a pre-selected portion of a pre-recorded video product, using a computer, a computer display and a telecommunications link between the remote user's computer and the network web site, the network web site] comprising:

- a) a networked central host server [coupled to a communications network for] that retrieves[ing] and transmits[ting the] a pre-selected portion of a[the] pre-recorded video product upon request by a remote user over a telecommunications link, the central

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host server hosting a web site that enables preview of pre-selected portions of pre-recorded video products on a computer associated with the remote user;

b) a central storage device that[for] stores[ing] pre-selected portions of a plurality of different pre-recorded video products, the central storage device coupled to the central host server;

c) machine executable programs of instructions that provide: an identification (ID) process that recognizes [a] user identification data[ID], transmitted from the remote user's computer to the central host server, which specifically identifies the remote user to the central host server prior to preview of the pre-selected portion of the pre-recorded video product by the remote user;[

d)] a tracking process that tracks the remote user's progress through the network web site;[

e)] a control process that provides the remote user with interactive control over preview of the pre-selected portion of the pre-recorded video product[s]; and[

f)] a demographic process, associated with the central host server, that collects demographic information regarding the user;

wherein data corresponding to the remote user's activities on the network web site is stored along with the user identification data in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them.

35. (Twice Amended) The computer system[network web site] of Claim 34 further comprising a machine executable program of instructions that provides a ratings process that prompts the user for a user rating of a particular one of the pre-selected portions of the plurality of different pre-recorded video products and stores the user rating

36. (Twice Amended) The computer system[network web site] of Claim 35 further comprising a machine executable program of instructions that provides a first market research process that correlates the user rating with the user identification data[ID], for compiling market research data.

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37. (Twice Amended) The computer system[network web site] of Claim 34 further comprising a machine executable program of instructions that provides a second market research process that correlates the user ID with all previews performed by the user, for compiling market research data.

38. (Once Amended) The computer system[network web site] of Claim 34 wherein the demographic information is selected from the group of information types consisting of age, sex, income, ethnicity, education level, marital status, hobbies, and occupation.

52. (Once Amended) The method of claim 21, further comprising a step of rating one of the pre-recorded video products, wherein the user is graphically provided with about 5[between 3 and 8] discrete rating selections on the computer display.

53. (Once Amended) The method of claim 21, further comprising a step of gathering, from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video[music] categories, configuration breakdowns, and demographic user profiles.

54. (Once Amended) The method of claim 22, wherein, in association with the rating step, the user is graphically provided with about 5[between 3 and 8] discrete rating selections on the computer display.

55. (Once Amended) The computer system[network web site] of claim 26, further comprising a machine executable program of instructions that provides a ratings process that prompts the remote user for a rating of one of the pre-recorded video products, wherein the user is graphically provided with about 5[between 3 and 8] discrete rating selections.

56. (Once Amended) The computer system[network web site] of claim 26, further comprising a machine executable program of instructions that provides a customizable market

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research process that gathers, from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video[music] categories, configuration breakdowns, and demographic user profiles.

57. (Once Amended) The computer system[network web site] of claim 31, wherein, in association with the rating process, the remote user is graphically provided with about 5[between 3 and 8] discrete rating selections[on the computer display].

58. (Once Amended) The computer system[network web site] of claim 34, further comprising a machine executable program of instructions that provides a ratings process that prompts the user for a rating of one of the pre-recorded video products, wherein the user is graphically provided with about 5[between 3 and 8] discrete rating selections.

59. (Once Amended) The computer system[network web site] of claim 34, further comprising a machine executable program of instructions that provides a customizable market research process that gathers, from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video[music] categories, configuration breakdowns, and demographic user profiles.

60. (Once Amended) The computer system[network web site] of claim 35, wherein, in association with the rating process, the user is graphically provided with about 5[between 3 and 8] discrete rating selections[on the computer display].

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